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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 01/29/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,949

Applicant(s)

PARCELS, JOSEPH S.

Examiner

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a method for attaching a protective cover to a corner of a frame, classified in class 156, subclass 202.
 - II. Claims 18-35, drawn to an apparatus for attaching a protective cover to a corner of a frame, classified in class 156, subclass 477.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process could be done by hand.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Chopin on 10/31/02 a provisional election was made with traverse to prosecute the invention of Group II, claims 18-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to, because it appears that Applicants inadvertently duplicated Figure 1 and omitted Figures 18-19. Since Figures 18-19 are just side views of Figure 17, it appears that there is support for all the elements discussed with respect to Figures 18-19 in the specification. Applicants can submit Figures 18-19 as an amendment to the drawings and they will be checked for new matter.

Claim Objections

6. Claims 18, 20, 24, 25, and 27 are objected to because of the following informalities:

Claim 18, line 1: insert --,-- after “frame”.

Claim 18, line 7: insert --,-- after “upwardly”.

Claim 18, line 8: insert --,-- after “frame”.

Claim 18, line 11: insert --,-- after “member”.

Claim 18, line 11: insert --,-- after “section”.

Claim 18, line 15: insert --,-- after “upwardly” and insert --,-- after “preform”.

Claim 20, line 2: insert --first-- before “frame”.

Claim 24, line 1: insert --,-- after “frame”.

Claim 24, line 25: insert --,-- after “spine flap”.

Claim 24, line 30: insert --,-- after “face cover flap”.

Claim 24, line 32: insert --,-- after “inner spine flap”.

Claim 24, line 33: delete “to a location” and insert --at a location--.

Claim 25, line 2: change “supporting means” to --support means--.

Claim 27, line 2: delete “support” and insert --supporting--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 18-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 18, it recites the limitation "the plane" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this to --a plane--.

Regarding claim 19, it recites the limitation "the upper surface" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this to --an upper surface--.

Regarding claims 20 and 22, it is unclear what is meant by perpendicularly inwardly and perpendicularly inwards, respectively, since claim 18 recites "downwardly and inwardly." Applicants are asked to clarify. It is suggested to change perpendicularly inwardly and perpendicularly inwards to --downwardly and inwardly--.

With respect to claim 24, it recites the limitation "the plane" in line 23. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this to --a plane--.

Art Unit: 1733

With respect to claim 24, it recites the limitation "the securement flap section" in line 25. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change this to --said securement flap--.

Regarding claim 28, it is unclear as to what is meant by "guide means for slidably receiving and holding in a fixed horizontal disposition relative to said support means." What is the guide means receiving and holding? Is it receiving and holding the frame? Applicants are asked to clarify.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18, 23-28, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnolfi et al. (EP 552589) in view of Doll (US 3725170) and the Admitted Prior Art in the specification of the present application.

With respect to claim 18, Magnolfi, directed to an apparatus for attaching a paper cover L to corners of a board S, teaches adhesive placed on the surface of the paper that will be in contact with the board (column 1, lines 22-25; column 4, lines 37-39), means (brush rotor 1) for bending upwardly a first flap section L1 of the paper adjacent to a side B1 of the board (Figure 19; column 4, lines 31-34), means (brush rotor 1) for bending the border of flap section L1 downwardly and inwardly towards the board such that the adhesive coated surface of the paper overlies the board (Figure 19), means (brush rotor 3) for bending upwardly a second flap section

Art Unit: 1733

L2 of the paper adjacent a side B2 of the board (Figures 19-20; column 5, lines 8-10 and 16-20), means (brush rotor 3) for bending the border of flap section L2 downwardly and inwardly towards the board such that the adhesive coated surface of the paper overlies the board (Figure 20), means (rollers 12, 14) for pressing the border of flap section L1 downwardly against the board to adhesively secure it to the board (column 4, lines 34-40), and means (rollers 26, 28) for pressing the border of flap section L2 against the board to adhesively secure it to the board (column 5, lines 13-19).

The reference is silent as to means for depositing the adhesive and the adhesive means depositing the adhesive on the board. It is known to deposit adhesive onto paper elements, such as cardboard elements that are intended to serve as corner protectors, by using an adhesive applicator, such as a spraying heads, as taught by Doll (column 5, lines 37-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to deposit the adhesive of Magnolfi using an adhesive applicator because such is known, as taught by Doll, and this allows the process to be automated.

It is noted that the material worked upon (protective cover) gets no weight in the apparatus, and therefore, the manner in which the apparatus cooperates with the material worked upon (applying adhesive to frame as opposed to cover) gets no weight in the apparatus. However, the skilled artisan would have readily appreciated that the adhesive applicator of Doll would have been capable of applying the adhesive to the board of Magnolfi, as opposed to the paper, just as the apparatus of Magnolfi would have been capable of attaching the paper to the corner of the board regardless of whether or not the adhesive is applied to the paper or the board.

Art Unit: 1733

It is also noted that the apparatus of Magnolfi would have been capable of attaching a protective cover to a frame corner, especially in light of the fact that it is known to attach a protective cover made of paper (i.e. cardboard) to a frame corner, as taught by the Admitted Prior Art (p. 1, line 10 – p. 2, line 5).

With respect to claim 24, all the limitations were addressed with respect to claim 18 except those pertaining to the corner protector preform and a support means. It is noted that the material worked upon (corner protector preform) gets no weight in the apparatus. Magnolfi teaches a conveyor 5 for supporting the board (column 5, lines 13-15).

Regarding claims 23 and 35, these limitations were addressed with respect to claim 18.

Regarding claim 25, Magnolfi teaches supporting the board on conveyor 5 but is silent as to releasably securing the board to the conveyor. It is notoriously well known and conventional to releasably secure objects to conveyors using various techniques including applying vacuum to perforations in the conveyor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the board of Magnolfi to the conveyor using a technique such as applying vacuum thereto because such is notoriously well known and conventional and this would keep the board from moving around during its various processing steps.

Regarding claims 26-27, selection of a particular mechanism for releasably securing the board to the conveyor would have been within purview of the skilled artisan at the time the invention was made.

Regarding claim 28, Magnolfi teaches guide means 20 for slidably receiving and holding the board in a horizontal position relative to the conveyor (column 4, lines 50-51).

Regarding claim 30, selection of a particular support means would have been within purview of the skilled artisan. However, Magnolfi teaches the conveyor, which acts like a tabular body, having a flat upper work surface.

Allowable Subject Matter

11. Claims 19-22, 29, and 31-34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#18 Regarding claim 19, the prior art fails to teach or suggest means for bending a flap section of the preform comprising a flap folder arm attached to a first end of an upwardly moveable linear actuator, wherein the arm is located in a recess of an upper surface of a worktable, below the preform, whereby upward extensional motion of the linear actuator forces the flap section to bend upwardly from the worktable surface.

Claims 20-22 depend on claim 19.

#29 Regarding claim 29, the prior art fails to teach or suggest the guide means comprising a pair of elongated blocks disposed obliquely to one another and having between converging longitudinal ends thereof a laterally disposed space adapted to receive a corner of the frame.

#36 Regarding claim 31, the prior art fails to teach or suggest means for bending a flap comprising a first flap folder arm having a flat wall surface disposed parallel to and spaced outwardly apart from the first frame channel member, and first linear actuator means for elevating the first flap folder arm vertically upward from a recessed portion of the tabular body.

Claims 32-34 depend on claim 31.

Art Unit: 1733

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 3955677, US 2885139, US 5297682, US 4529091, US 5255458.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



jlr
January 22, 2003



Michael W. Ball
Supervisory Patent Examiner
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